

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID LARS EHNEBUSKE, BARBARA JANE ALSPACH MCKEE,
STEWART LAUNDON PALMER, JAMES THOMAS RAYFIELD, ISABELLE MARIE
CATHERINE ROUVELLOU, and IAN DAVID SIMMONDS

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PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2004-1429
Application No. 09/204,971

ON BRIEF

Before KRASS, JERRY SMITH, and GROSS, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-29, which constitute all the claims in the application.

The disclosed invention pertains to a method and apparatus for performing general integrity checks using rules in an application running on a data processing system.

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Representative claim 1 is reproduced as follows:

1. A method for performing general integrity checks using rules in an application running on a data processing system comprising:

identifying a point in a unit of work where application state integrity is to be verified, wherein the unit of work includes a plurality of participants;

responsive to determining that the unit of work is to be completed, obtaining rules associated with each participant in the unit of work; and

responsive to obtaining the rules, running the rules obtained for each of the participants to verify the integrity of an application state, according to the plurality of participants.

The examiner relies on the following references:

James Martin (Martin), Principles of Object-Oriented Analysis and Design, pp. 1-411 (Prentice-Hall Int'l, publ. Jun. 1, 1992 per Library of Congress).

Steve McConnell (McConnell), "Characteristics of High-Quality Routines," Code Complete: A Practical Handbook of Software Construction, pp. 94-109 (Microsoft Press, publ. Apr. 16, 1993 per Library of Congress).

George McDaniel (McDaniel), IBM Dictionary of Computing, pp. 1, 119, 185, 586 and 597 (McGraw-Hill, Inc., Aug. 1993).

Claims 1-29 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Martin in view of McConnell and McDaniel.

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Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-29. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual

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determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicants to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039-40, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468,

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1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii) (2004)).

We consider first the rejection with respect to independent claims 1, 12, 19 and 25 which stand or fall together as a single group (brief, page 3), and we will consider claim 1 as the representative claim for this group. The basis for the examiner's rejection of claim 1 is set forth at pages 5-6 of the examiner's answer.

Appellants argue, inter alia, that although Martin teaches the use of integrity rules and states that these rules indicate that something must be true, Martin does not teach the specific use of integrity rules as claimed. Specifically, appellants argue that Martin does not teach or suggest units of work as claimed or operations on units of work as claimed. Appellants also argue that Martin does not teach the identification of a point in a unit of work where application state integrity is to be verified. Appellants argue that the portions of Martin identified by the examiner do not teach units

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of work having a plurality of participants. In summary, appellants argue that the very general teachings of Martin have nothing to do with the specific invention of claim 1. Appellants also argue that the teachings of McConnell and McDaniel do not overcome the deficiencies of the Martin reference (brief, pages 4-11).

The examiner responds that appellants have not properly traversed his definition of the term "unit of work." The examiner also points out that he has interpreted the term "participants" to mean the methods used in object technology and that appellants have not traversed this definition. In summary, the examiner responds that appellants have made only very general arguments and have failed to clearly explain the errors in the rejection (answer, pages 7-13).

Appellants respond that none of the portions of Martin that are specifically relied on by the examiner teach or suggest the specific recitations of claim 1 (reply brief).

We will not sustain the examiner's rejection of independent claims 1, 12, 19 and 25 or of any of the claims which depend therefrom for essentially the reasons argued by appellants in the briefs. We agree with appellants that the examiner's interpretations of a "unit of work" and a "participant" as

claimed are not reasonable interpretations of the claimed invention. In particular, we fail to see how the claimed plurality of participants can be interpreted to read on the methods associated with any object instance. The examiner has essentially interpreted the claimed invention as being met by the rules associated with any object oriented system. Despite the fact that the claimed invention might be considered broad by the examiner, we are of the view that the examiner has failed to give the claims a reasonable interpretation as required. Since we find that the examiner's definitions of the terms used in the claimed invention are not reasonable, the rejection based on these definitions fails to establish a prima facie case of obviousness.

Since separately argued independent claims 8, 22 and 28 contain limitations similar to the limitations of representative claim 1, we also do not sustain the examiner's rejection of these claims or of any of the claims which depend therefrom.

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In summary, we have not sustained the examiner's rejection of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-29 is reversed.

REVERSED



JERRY SMITH)
Administrative Patent Judge)

Errol A. Krass)
Administrative Patent Judge)

Anita Pellan Gross)
Administrative Patent Judge)

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